

Application Serial No.:
10/035,659

Attorney Docket No.:
SP01-302

REMARKS

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding Office action is respectfully requested.

By virtue of the claim amendments supra, claims 1-21 are canceled without prejudice. Claim 32 has been canceled previously without prejudice as a result of a restriction requirement which was made final in the outstanding Office action. Applicants reserve the rights to file a divisional application for it. Claim 22 is currently amended. Originally filed claims 23-31 remain unchanged in the present application. No new claim is added.

I. Information Disclosure Statements

Applicant notes that the Examiner did not consider the references cited in the IDS' filed by Applicants dated February 2, 2004, November 6, 2002 and October 26, 2001.

Applicant has provided further explanation of the references in those information disclosure statements in a response filed on September 2, 2004. Applicant has further requested the Examiner to consider those references identified in those references in the same submission.

Nonetheless, the Examiner still did not consider the references identified in these information disclosure statements.

It is the Examiner's obligation to consider the references identified by Applicant and submitted in timely filed Information Disclosure Statement.

Since the Examiner did not consider those references, when they were provided in compliance with the PTO's requirements, the current final Office action was issued prematurely. These references may contain evidences in support of the patentability of the invention as claimed in the present application. Applicant is denied an opportunity to have the references considered during the prosecution by virtue of this premature final action.

II. Amendments

The amendment to claim 22 is supported by paragraph [00031] and FIG. 3B of the present application. Therefore, no new matter is introduced as a result. Further, the cancellation of claims in this amendment places the application in a better position for appeal. Therefore, it is respectfully requested that the amendment is entered.

III. Rejections under 35 U.S.C. § 112

The Examiner has rejected claim 3 under 35 U.S.C. § 112, both first and second paragraphs. Applicant has canceled claim 3 without prejudice, rendering this rejection moot.

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V. Rejections under 35 U.S.C. § 103

In a rejection under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie obviousness case. If the Examiner does not produce a prima facie obviousness case, the applicant is under no obligation to submit evidences of non-obviousness. The MPEP, Eighth Edition, 2142.

A proper prima facie case of obviousness requires the examiner to satisfy three requirements. First, the prior art relied upon, coupled with knowledge generally available to one of ordinary skill in the art, must contain some suggestion which would have motivated one of ordinary skill to combine references. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Second, the examiner must show that, at the time the invention was made, the proposed modification had a reasonable expectation of success. See Amgen v. Chugai Pharm. Co., 927 F.2d 1200, 1209, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Finally, the combination of references must teach or suggest each and every limitation of the claimed invention. See In re Wilson, 424 F.2d 1832, 1385, 165 USPQ 494, 496 (CCPA 1970). Moreover, both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. In re Vaack, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

(1) The rejection over Le Noane et al. in view of Coucoulas et al.

Applicant notes with appreciation that the Examiner has withdrawn the rejection over Le Noane et al. in view of Coucoulas et al.

(2) The rejection over Le Noane et al. (or Sterling et al.) in view of Gwo

The Examiner further rejected claims 1-3 and 13-31 under 35 U.S.C. § 103(a) as being unpatentable over Le Noane (or Sterling (United States Patent No. 4,195,980)) in view of Gwo (United States Patent No. 6,284,085).

The Examiner asserted that

LeNoane (as well as Sterling) discloses the bonding of glass performs, but not the temperature limitation. Gwo teaches that one can create a strong room-temperature bond in a manner which is simple and inexpensive. It would have been obvious to change the Le Noane (or the Sterling) process, by using the improved bonding procedures of Gwo, for the advantages of Gwo. Relevant portions of Gwo include the abstract, col. 1, lines 22-29, from col. 1, line 61 to col. 2, line 19, col. 3, lines 37-62; col. 6, lines 42-62.

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The Examiner further enumerated reasons for the rejection of claims 1, 2, 3, 13-31. Applicant has canceled claims 1-21, rendering the rejections thereof moot.

Applicants respectfully traverse the above rejections of claims 22-31, with the above claim amendments duly taken into consideration.

Sterling et al. teaches a method in which the fiber preforms are bonded at a temperature higher than 300°C. Le Noane et al. teaches the bonding of fiber preforms and drawing thereof into fibers. The limited teaching as to bonding of the preforms are reproduced as follows:

The bars are then successively introduced into the apparatus where they are welded to each other at a welding station, forming a part of the apparatus. Referring to FIGS. 3 and 4, there are shown two successive bars 7 and 8 being welded at station 10. The bars are guided and moved continuously by driving means, shown schematically in FIG. 3 as comprising two sets of rollers 11 placed upstream of welding station 9 and a set of centering rollers 12 placed downstream.

Column 4, lines 2-11, Le Noane et al.

Gwo teaches direct bonding of surfaces that can be effected at a low temperature. However, Gwo does not teach the direct bonding of fiber preforms.

However, none of the references Gwo, Le Noane et al. and Sterling et al. teaches or suggests the direct bonding of sacrificial fiber preforms with fiber preforms followed by drawing fiber from the lower sacrificial preform.

Therefore, Applicant respectfully submits that the combination of Le Noane et al. (or Sterling et al.) with Gwo does not establish a prima facie obviousness case of claims 22-31, as amended, because the combination does not teach or suggest all the claim limitations.

Therefore, Applicant respectfully requests the Examiner withdraw this rejection under 35 U.S.C. § 103 over Le Noane et al. (or Sterling et al.) in view of Gwo of the outstanding claims 22-31.

VI. Conclusion

Applicants believe that the claims being examined are not unpatentable over the references the Examiner considered. Applicants believe other issues the Examiner raised in the outstanding Office action have been resolved.

Applicant respectfully petitions the Group Director to withdraw the premature finality of the present Office action.

Applicant respectfully requests the Examiner to consider the references Applicants submitted previously in the next Office action.

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Should the Examiner find the outstanding claims not unpatentable over the references submitted previously and to be considered by the Examiner, the Examiner is requested to issue a notice of allowance on the outstanding claims in the next Office action.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error, Applicants respectfully request that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorize the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

The undersigned attorney is granted limited recognition by the Office of Discipline and Enrollment of the USPTO to practice before the USPTO in capacity as an employee of Corning Incorporated. A copy of the document granting such limited recognition either has been previously submitted or is submitted herewith for the record.

Please direct any questions or comments to the undersigned at (607) 248-1253.

Respectfully submitted,

Date: December 20, 2004



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Date of Deposit: _____
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date indicated above with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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I hereby certify that this paper and/or fee are being facsimiled to the Commissioner of Patents, at 703-872-9306.

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